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Attn: Mr. Robert W. Bahr
U.S. Patent and Trademark Office
Washington, D.C. 20231

Re: Comments on Notice of Proposed Rulemaking; Changes to Implement 18-Month Publication
of Patent Applications

Dear Sir:

Please consider the following comments relating to the notice of proposed rulemaking referenced above.

As a general matter, the proposed rules appear to be carefully thought out and well drafted. However, I believe that they could be improved with respect to the following matters.

(1) The rules relating to public availability and redaction of file histories are contrary to the legislative intent and are not practical. (Rules 11(a), 14(c)(2) and (e), 217, etc.)

35 U.S.C. §122(a) requires that "except as provided in subsection (b)," patent applications shall be kept in confidence and no information concerning them shall be given without special authority. Subsection (b) authorizes publication of patent applications, not file histories. It specifically states that "no information concerning published patent applications shall be made available to the public except as the Director determines," thus making clear the intent of Congress that the key information to be published is the content of the patent applications themselves. This also reflects the intent stated in the section-by-section analysis in the legislative history, in which the intent of the publication statute was to "ensure that American inventors will be able to see the technology that our foreign competition is seeking to patent much earlier than is possible today." The technology is disclosed in the patent application; applicants are prohibited from adding to the disclosure of the technology during prosecution under 35 U.S.C. §132(a). The discretion for the Director to determine that additional information should be published would appear to best be served by release of bibliographic information, not every detail of the prosecution of patent applications after they are filed. Thus publication of the application document alone with appropriate bibliographic information would appear to best satisfy the clear legislative intent to make the technology available without making more information about the application available than is necessary.

Maintenance of the prosecution files in confidence also eliminates many practical problems that are apparent from the proposed rules. In fact, it is already extremely difficult to obtain copies of pending patent applications even in the limited circumstances in which they are now available. For example, it routinely takes weeks or months to obtain a copy of a reissue application file or reexamination file, as reflected by the recent case of Taboada v. Dickinson, in which a member of the public had to bring a civil action against the Commissioner to obtain a copy of a reexamination file after having tried to obtain it for many months. The concept of using Patent Office personnel or outside contractors to make the copies does not remedy that problem at all; to the contrary, it would most likely result in the files being left unavailable to both the Examiner and the public for long periods of time, thus frustrating the intent of the statute relating to patent term guarantee.

In addition, the rules relating to redaction of patent applications and their entire prosecution histories are extremely burdensome. The requirement to provide redacted copies and pay substantial fees for every paper that is filed or mailed in the prosecution of a patent application within an extremely short time period of only one month is too burdensome for small entities or independent inventors. These patent applicants, who were supposed to be "protected" by the "American Inventors' Protection Act of 1999," would be the key people left unprotected by the redaction rules. It is simply unrealistic to expect such applicants to be able to afford the repetitive fees, the Electronic Filing System (EFS) software and the expertise or attorney time needed to provide quick, redacted copies of all Patent Office mailings and filings in order to prevent the laying open an entire file history of a redacted application. Maintaining the confidentiality of prosecution histories would eliminate this as an issue and far simplify the requirements on both the PTO and on applicants, while simultaneously better reflecting the legislative intent.

2. The rules requiring use of the Electronic Filing System (EFS) are premature and unnecessarily burdensome. (Rule 217, etc.)

It is appreciated that the commentary indicates that the PTO expects to waive the EFS-based rules if the EFS system is not in place by November 29. However, it is respectfully submitted that it is premature to put the rules in place without any certainty that the EFS system will be available and without large scale experience with the EFS by both the PTO and the intellectual property community. In addition, the EFS-based rules in the proposals in several cases put form before substance by prohibiting certain applicants from obtaining the benefits of the legislation due to inadequacy and/or unavailability of the EFS.

For example, Rule 84(a)(2) acknowledges that on some occasions, color drawings may be necessary as the only practical medium by which to disclose the subject matter sought to be patented. However, the same rule prohibits filing color drawings with the EFS. Coupled with the redaction rules requiring use of the EFS (e.g., Rule 215(c)), this essentially eliminates from the protection of the statute any applicant who has made one of the inventions that require color drawings "as the only practical medium by which to disclose the subject matter sought to be patented." This is unfair and contrary to the intention of the statute to protect all applicants equally.

In addition, the equipment, software and expertise necessary to use the EFS is not widely available, particularly in the independent inventor and small entity community. A requirement for use of

the EFS in order to obtain protection from the "the American Inventors' Protection Act of 1999" is clearly contrary to the legislative intent of that act when it leaves independent inventors and small entities as the most likely applicants to be unable to enjoy the protection of the act.

(3) It is also respectfully submitted that the rigid requirements for early and complete formalization of drawings in the proposed rules are inappropriate. Rule 84, 85(a) and Rule 211(c).

It is clear that at least some minimum requirements for drawings must be met for patent applications to be published. For example, they must meet size and visibility requirements to permit their reproduction in a publication. However, there is no need for them to meet all of the requirements of Rule 84 in an application that may or may not be patented. Particularly in light of the PTO's own statistics that approximately 1/3 of patent applications are abandoned, requiring complete formalization of drawings in all applications will present a very heavy time and cost burden on patent applicants. Furthermore, the percentage of applicants who abandon applications is probably higher among small entities, who, according to the PTO statistics, file some 60,000 applications each year. Thus, at least 20,000 of those applicants, and probably more, would be burdened by significant drawing costs at an early stage in the patenting process when their resources are being most heavily strained. Thus, I would recommend that two levels of drawing formalization be implemented, one with the minimum requirements for publication, and one for issuance of a patent. Only the minimum requirement should have to be met within the early time frame required for 18-month publication. The last sentence of Rule 85(a) should thus be applied in all applications, not merely design applications. The remainder of Rule 85(a) should be deleted.

Furthermore, the requirement that drawing corrections normally would not be held in abeyance until allowance is unduly burdensome. In most cases, detailed drawing requirements are not imposed until examination has begun, which is frequently well after the publication process has begun. Once the drawings are en route to publication, there is no need for further formalization of the drawings before allowance. Since this is the stage where most applications that are abandoned become abandoned, postponing drawing formalization protects applicants from unnecessary expenses. The rules regarding applicant delays can avoid inappropriate conflict with patent term guarantee statutory sections.

In addition, the elimination of the right to mount photographs in Rule 84(e) conflicts with Rule 84(b) (1)(ii) and imposes a significant additional expense on applicants.

(4) Rule 99's prohibition on any explanation or other information concerning cited references is too restrictive, and Examiners should be required to consider information properly cited under Rule 99.

The need to avoid argumentation in Rule 99 submissions is appreciated. However, it is often difficult to locate specific material information within the body of a reference. Thus submitters should be permitted to submit some information concerning at least the location of material information within a reference - e.g., by a concise reference to page or column and line numbers or even bracketing in margins (although the latter may be undesirable if it is not readily reproducible when file history copies are made).

Furthermore, Rule 99 limits the number of references that may be cited to a very manageable number. Thus Examiners should be required to consider all of the properly cited references, even if they decide that the references are not material. Furthermore, they should be required to make of record

such consideration, much like they are required to do under Rule 97. This will serve to eliminate substantial confusion and litigation burden, including depositions of Examiners as to what they did or did not consider. Since the rule commentary appears to require Examiners to consider submitted references at least to the extent necessary to determine whether or not they are pertinent, there would be no extra burden on the Office from such consideration of record.

(5) The second sentence of Rule 131(a) is unnecessary, and inappropriately omits reference to 35 U.S.C. §102(a). Also, the phrase "by reference to acts" appears to have been inadvertently omitted in the subsequent two sentences, since there is no issue concerning establishing prior invention in any other countries: prior invention is only established in the U.S. PTO under U.S. statutes, possibly with reference to acts that have taken place in other countries.

(6) Rule 132 should be available to traverse a rejection based on a patent application publication of an application which has issued as a patent, without reference to the claims in the publication if they are different from the claims in the patent. For example, an applicant should not be prohibited from using a Rule 132 Declaration to overcome a rejection based on an application publication that has clearly unpatentable claims that are nowhere found in the corresponding resulting patent.

(7) Rule 137(d)(2) appears unnecessary, particularly in view of Rule 137(d)(1)(ii) and Rule 137(d)(3). The period of abandonment cannot act to increase the term of a patent on an application filed after June 8, 1995, and thus the requirement for a Terminal Disclaimer is redundant in such a patent. Nor is there any need to require co-ownership of the resulting patents in the context of Rule 137, particularly with respect to divisional applications.

In addition, the Terminal Disclaimer requirements imported into Rule 137(f) through Rule 137(b) appear to be inappropriate, since the abandonment under Rule 137(f) will generally be unknown to the Office and thus will not delay prosecution and issuance of the patent.

(8) The requirement for a separate paper in Rule 215(b) is ambiguous and potentially unnecessarily burdensome.

It is not clear from Rule 215(b) whether the separate paper need merely be separate from the application itself, or need be separate from all other papers, including an application transmittal letter. It would appear that an application transmittal letter is the most appropriate place for inclusion of Assignee information for printing on the publication, along with other bibliographic information for the application. Thus to the extent the rule can be construed merely to require that the paper is separate from the application itself, but not necessarily from a transmittal letter for the application, it is of appropriate scope but merely ambiguous. To the extent that it requires an entirely separate paper, there is no apparent reason why each item of bibliographic information should not also be on a separate paper, thus multiplying the number of papers in the application and unduly burdening both applicants and the Patent Office.

(9) Rule 217(b) is unduly burdensome and without any apparent logical basis.

Problems with requiring EFS submission of documents are separately addressed above. However, Rule 217(b) unnecessarily discriminates between permitting a full application to be filed on paper as the basis for publication, whereas a redacted application filed on the same day must be filed under the EFS. Clearly, a paper application submitted on the filing date can be used for publication, whether it is the full application or the redacted application. Imposing the additional burdens of EFS filing for those applicants taking advantage of the redaction provision of this statute even though they filed the redacted copy on the same day as the application is unfair.

(10) The requirements in Rule 217(c)(1-3) are unnecessary. Rule 217(c)(4) imposes a certification obligation on applicant. The additional and very substantial expense of translations and copies to prove the veracity of the certification are unnecessary. They will bulk up Patent Office files with highly redundant information which can be readily gleaned by interested parties from the normal filing documents. In view of the certification, there should be no need for their use by the Office, thus they impose burden and expense on both the PTO and applicant without any need therefore. The corresponding requirements relating to post filing submissions are also unnecessary.

(11) The refusal to include paper copies of the patent application publications in the public search room and the Examiners' search rooms will lead to significant incompleteness of the search files, degrading the integrity of all paper searches and likely resulting in the issuance of many more invalid patents than are issued today. While computer searching of patent documents has improved significantly, there are still many categories of invention that are best searched on paper. In addition, there is far greater access to the paper files than to the limited number of computer terminals in the public search room. Whereas many searches can be conducted today without resort to the computer terminals, when published applications are only available through the computer terminals, every search will need to use them. Thus it is respectfully submitted that failure to include paper copies in the search rooms will degrade the U.S. patent system.

Respectfully submitted,

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